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John T. Pienkos 10019 N. Miller Ct. Mcquon, WI 53092			MORGAN, ROBERT W	
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN THADDEUS PIENKOS

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Appeal 2010-003243  
Application 09/694,402  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

### STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claim 26 which is the only pending claim in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

### SUMMARY OF THE DECISION

We REVERSE.

### THE INVENTION

The Appellant's claimed invention is directed to a system that allows insured users to specify limited times, regions, or other restrictions concerning usage of their insured items (Spec.3:21-25). Claim 26, reproduced below, is the sole claim on appeal.

26. A method of providing insurance coverage to a customer, the method comprising:

(a) during a preliminary period of time:

- (1) receiving an initial inquiry from the customer;
- (2) providing an input form including at least one field for an entry of a piece of information concerning at least one of a characteristic of the customer and a characteristic of an item to be insured;
- (3) receiving the piece of information following its entry into the input form and submission;
- (4) performing processing in relation to the piece of information;

- (5) providing a preliminary indication to the customer that the customer will have an ability to order at least one of temporally-limited amounts of insurance and geographically-limited amounts of insurance; and
- (6) providing an identifier to the customer;

and (b) at a subsequent period of time:

- (1) providing a field for an input of a limitation relating to a desired insurance coverage regarding a customer-owned item, the limitation including a time period indication of a time period less than a month;
- (2) receiving the limitation at a central processor as provided by way of a customer-operated terminal;
- (3) performing processing in relation to the limitation to determine whether the desired insurance coverage as restricted by the limitation can be provided;
- (4) sending a confirmation to the customer-operated terminal concerning whether the desired insurance coverage corresponding to the limitation can be provided;
- (5) receiving a further signal from the customer-operated terminal indicating that the desired insurance coverage is still desired;
- (6) concluding an arrangement so that the desired insurance coverage concerning the time period is provided to the customer;
- (7) receiving credit card information from the customer, wherein the central processor does not bill a customer credit card for the desired insurance coverage as restricted by the limitation until the central processor receives a confirmation from the customer-operated terminal via an internet-type

connection that a newly-quoted price for the desired insurance is satisfactory; and

(8) recording information regarding the desired insurance coverage as restricted by the limitation in an insurance company database.

#### THE REJECTION

The Examiner relies upon the following as evidence in support of the rejections:

Luchs	US 4,831,526	May 16, 1989
Pescitelli	US 5,845,256	Dec. 1, 1998
Underwood	US 5,873,066	Feb. 16, 1999
Cullen	US 6,272,528 B1	Aug. 7, 2001

*Rental Car Insurance: Staying out of Financial Potholes*; Bruce Felton, New York Times Late Edition, East Coast, Mar. 23, 1997 pg.3.11, pages 1-3.

The following rejection is before us for review:

1. Claim 26 is rejected under 35 U.S.C. § 103(a) as unpatentable over Luchs, Felton, Cullen, Underwood, and Pesticelli.

#### THE ISSUES

This issue turns on whether it would have been obvious to modify the prior art references of Luchs, Felton, Cullen, Underwood, and Pesticelli to meet the limitations of claim 26.

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>1</sup>

- FF1. Luchs has disclosed a computerized Insurance Premium Quote Request and Policy Issuance System (Title).
- FF2. Luchs at Col. 1:50-62 describes that in the prior art that clients can request supplemental coverage or riders to new policies that must be written and resubmitted for approval.
- FF3. Felton has disclosed that coverage may be provided for a car rental for up to 15 days on Mastercard Gold and up to 30 days for American Express (page 2).
- FF4. Cullen has disclosed the delivery of general insurance on the Internet (Abstract).
- FF5. Underwood has disclosed that for an insurance contract that is known to document and store information related to risk (1:60-64).

## ANALYSIS

The Appellant argues that the rejection of claim 26 is improper because in part the Examiner has used improper hindsight reasoning to arrive at the claimed invention (Br. 11, 13).

In contrast, the Examiner has determined that the rejection of record is proper and that the cited combination of references to meet the limitations of claim 26 would have been obvious (Ans. 7-11).

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

We agree with the Appellant. We begin by noting that the Appellant has not disputed that the cited prior art discloses the claimed elements (Br. 10-12) with the exception of arguing that the prior art does not show claimed second set of steps that occurs “(b) at a subsequent period of time” (Br. 12). The Examiner in contrast has noted that Luchs discloses that clients request supplemental coverage, riders, or new policies (Col. 1:51-57) which would disclose this limitation. As a result, the Appellant has not shown that the cited prior art fails to disclose any claimed elements and the issue comes to one of obviousness.

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Supreme Court at 418 noted that in an obviousness analysis that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. Here, the modification of Luchs to include a shorter time insurance period as taught by Felton, to be Internet based as taught by Cullen, to use computer storage as taught by Underwood, and to use a credit card payment as taught by Pescitelli in the particular sequence claimed in the method lacks articulated reasoning with some rational underpinning to support a legal conclusion of obviousness. We note for example that Luch’s disclosure of supplemental policies and riders appears in the Background section describing prior art and that claim 26 requires a specific manner in

which the credit card is to be used (see claim limitation (7)) and the cited rationale appears to use impermissible hindsight in this case. The Examiner has crafted a well detailed analysis of the elements of claim 26 but in the case the issue of obviousness lacks the required rational underpinnings when considering claim 26 in whole. For these reasons the rejection of claim 26 is not sustained.

#### CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 26 under 35 U.S.C. § 103(a) as unpatentable over Luchs, Felton, Cullen, Underwood, and Pescitelli.

#### DECISION

The Examiner's rejection of claim 26 is not sustained.

REVERSED

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